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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Bankstahl, Herbert A.
Serial No. : 10/711,475
Filed : September 21, 2004
For : HIGH-POWER ELECTRICAL QUICK CONNECTOR
Group Art No. : 2833
Examiner : Phuongchi T. Nguyen

CERTIFICATION UNDER 37 CFR 1.8(a) and 1.10

I hereby certify that, on the date shown below, this correspondence is being:

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**PETITION UNDER 37 C.F.R. §1.144 SEEKING
SUPERVISORY REVIEW OF RESTRICTION REQUIREMENT**

Dear Sir:

Responsive to the Restriction Requirement made Final May 9, 2006, Applicant requests Supervisory Review and consideration of the following remarks in support of the rejoinder of claims 16-105 and 109 with claims 1-15 and 106-108.

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REMARKS

In the Office Action mailed August 11, 2005, the Examiner identified two inventions, Inventions I and II, and eight alleged "species" of Invention I in the pending application. The Examiner classified species 1 as Figures 1-12, species 2 as Figures 13-17, species 3 as described in paragraph 56 of the specification, species 4 as described in paragraph 58 of the specification, species 5 as described in paragraph 59 of the specification, species 6 as described in paragraph 60 of the specification, species 7 as described in paragraph 61 of the specification, and species 8 as described in paragraph 57 of the specification. The Examiner required Applicant to elect a single species for prosecution on the merits.

In a timely response mailed September 12, 2005, Applicant elected, with traverse, what the Examiner characterized as Invention I. From Invention I, Applicant further elected what the Examiner had identified as species 2. The Examiner maintained the Restriction and withdrew claims 16-105 and 109 from consideration in the Office Action mailed November 23, 2005.

The Examiner concluded that Inventions I and II are distinct because they are "related as process of making and product made." *Restriction Requirement, August, 11, 2006, p. 2.* Citing MPEP § 806.05(f), the Examiner stated that the product could be made by another and materially different process because "the electrical connection as claimed can be formed by forcing or pressing the plug into the socket, without any step of rotation." *Id.* The Examiner's statement, however, that the connection can be formed by forcing or pressing disregards elements called for in the claims and would actually result in damage and complete destruction to the end product. Claims 42 and 47, identified as Invention II, each call for a connector assembly having a pair of respective parts wherein engagement is achieved upon rotation therebetween. Claim 1, of Invention I, calls for, in part, a quick connector assembly having a stem portion having a threaded segment and a second connector having a recess constructed to receive the stem portion of the first connector and engage the threaded segment thereof. Claim 3, which depends from claim 1, further defines the threaded engagement wherein the first connector is rotatable relative to the second connector. The Examiner's interpretation that the "product" of the claims of Invention I could be formed by "forcing or pressing" the constituent components together disregards portions of that which is called for in claims 1 and 3, namely parts that threadingly engage. These limitations cannot be disregarded. Furthermore, one of ordinary skill in the art would recognize that engaging threaded parts cannot be accomplished by "forcing or pressing" the parts together but requires rotation between the parts of the assembly. That is, a person of ordinary skill in the art would readily appreciate that "forcing or pressing" threaded parts together without rotation would defeat the purpose of forming a threaded connection and result in destruction to the parts, if it is even possible at all. For at least these reasons, the Examiner has not set forth a proper restriction between the claims of Inventions I and II and these claims should therefore be rejoined.

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With respect to the species restriction, the Examiner made no arguments in support of the statement that the claims were patentably distinct species in the original Restriction of August 11, 2005. Instead, the Examiner merely stated that claims directed to patently distinct species were "specie 1 (Figures 1-12), specie 2 (Figures 13-17), specie 3 (No Figure) (see page 17, [Para 56]), specie 4 (No Figure) (see page 17, [Para 58]), specie 5 (No Figure) (see page 17, [Para 59]), specie 6 (No Figure) (see page 18, [Para 60]), specie 7 (No Figure) (see page 18, [Para 61]), specie 8 (No Figure) (see page 17, [Para 57])." *Id. at p. 2-3.*

Responsive thereto, Applicant argued that, with respect to alleged species 3-8, the Examiner had not identified any "species" and the subject matter of each paragraph identified by the Examiner corresponds to a respective independent claim. That is, the Examiner identified species 3 and cited paragraph 56 as illustrating such. Similarly, with respect to species 4, the Examiner cited paragraph 58 in support of the identification of species. Likewise, the Examiner identified species 5 and cited paragraph 59, identified species 6 and cited paragraph 60, identified species 7 and cited paragraph 61, and identified species 8 and cited paragraph 57 in support of the identification of species. The Examiner simply attempted to identify species based on claim elements of the independent claims. Applicant argued that one will readily recognize that the subject matter of paragraph 56 corresponds to the elements of claim 19, the subject matter of paragraph 58 corresponds to the elements of claim 42, the subject matter of paragraph 59 corresponds to the elements of claim 47, the subject matter of paragraph 60 corresponds to the elements of claim 61, the subject matter of paragraph 61 corresponds to the elements of claim 70, and the subject matter of paragraph 57 corresponds to the elements of claim 93. These paragraphs merely summarize the invention as claimed.

The six paragraphs cited by the Examiner as disclosing allegedly distinct "species" of the present invention are found in the Brief Description of the Invention and are repeated in the Detailed Description, with each alleged embodiment being a so-called separate species. However, even a cursory comparison of the cited paragraphs to the six independent claims of the present Application quickly elucidates that the language of paragraphs 56, 58, 59, 60, 61, and 57 is substantially identical to that of each of the nine independent claims. More specifically, paragraph 56 (species 3) corresponds to claim 19, paragraph 58 (species 4) corresponds to claim 42, paragraph 59 (species 5) corresponds to claim 47, paragraph 60 (species 6) corresponds to claim 61, paragraph 61 (species 7) corresponds to claim 70, and paragraph 57 (species 8) corresponds to claim 93. Thus, the Examiner has effectively restricted claims as species and has not identified actual embodiments of the alleged species. Section 806.04(e) of the MPEP is very clear in stating that "[c]laims are never species.... Species are always the specifically different embodiments." Therefore, the present restriction attempts to circumvent this mandate by restricting between paragraphs

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of the Application which are paragraph-form summaries of the independent claims. Such a manner of restriction is improper, unsustainable, and must be withdrawn.

MPEP §806.04(e) clearly sets forth that the Examiner's species restriction is improper because "[c]laims are never species." MPEP §806.04(e). The Examiner attempted to circumvent the rule by citing to portions of the specification—which is nothing more than form over substance when the specification contains paragraphs that merely correspond to independent claims. Therefore, the Examiner effectively attempted to proffer a species election based solely on the claims. *See Id.* The Examiner cannot attempt to identify species based simply on the fact that there are multiple independent claims. The Examiner's attempt to sidestep the requirements of MPEP §806.04(e) is improper, and therefore, the restriction is not sustainable. The Examiner did not present any proper grounds for a species restriction and has not provided any support for a species restriction.

Specifically, as stated in MPEP §806.04(b), species can be either independent or distinct. For independent species, the Examiner must show that "species under a claimed genus are not connected in any of design, operation, or effect." MPEP §806.04(b). The Examiner has failed to show that the species are not connected in any of design, operation, or effect. The Examiner merely concluded that the species were patentably distinct based on non-material differences in the individual words of the species 2 claims and the claims cited for each of the other alleged species. *See Office Action, May 9, 2006, p. 2.* This alone does not show that the Examiner's identified species are independent because a restriction requirement must be based on claim elements, not simply preamble language. Furthermore, Applicant believes Examiner cannot show distinctness of any of the species with respect to another. Thus, the Examiner has not met the burden under MPEP §806.04(b) to show independent species.

Alternatively, for the Examiner to show that inventions are related as disclosed and distinct as claimed, "the question of restriction must be determined by both the practice applicable to election of species and the practice applicable to other types of restrictions such as those covered in MPEP §806.05 – §806.05(j)." MPEP §806.04(b). The Examiner made no attempt to show that the species are distinct under any section of MPEP §806.05 – §806.05(j). Additionally, the Examiner "must explain why there would be a serious burden on the examiner if restriction is not required." MPEP §808.02. The Examiner may show a serious burden by separate classification, separate status in the art, or a different field of search. *See Id.* The Examiner failed to show any separate classification, any separate status in the art, or any different field of search. Thus, the Examiner failed to meet the requirements as set forth by MPEP §806.04(b) and MPEP §808.02.

In sum, the Examiner has not provided a valid basis for restriction between species 2, 3, 4, 5, 6, 7, and 8. At best the present application contains two (2) patentably distinct species: species 1 and species 2. The present restriction with respect to species 2-8 is improper since it effectively restricts claims and

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not embodiments. This failure to identify distinguishable characteristics indicates that the restriction required by the Examiner cannot be substantively supported.

Additionally, the Examiner restricted species 8, claims 85-105 and 109 because "species 2 does not have the torch." *Office Action, May 9, 2006, p. 3*. Although the Examiner included claim 109 in species 8, claim 109 depends from claim 106, which the Examiner included in species 2. Since claim 109 depends from elected claim 106, the Examiner's withdrawal of claim 109 is improper. Furthermore, claims 85-105 are not related to nor mention the use of a 'torch.' The Examiner has failed to address any of the elements required to satisfy the burden required in making any restriction requirement, let alone a species restriction. As such, the restriction requirement in the Final Office Action mailed May 9, 2006 is grossly inadequate and not sustainable.

For at least these reasons, Applicant respectfully requests that the restriction be withdrawn. Accordingly, Applicant respectfully requests rejoinder of all claims.

Applicant believes no fee is due for filing this Petition. However, should a fee be deemed necessary, Applicant hereby authorizes charging of Deposit Account No. 50-2623.

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Respectfully submitted,

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